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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,151	06/16/2005	Ulrich Berens	VT/95-22814/A/PCT	2741
324 7590 03/01/2007 CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			EXAMINER NOLAN, JASON MICHAEL	
			ART UNIT 1626	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/01/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/539,151

Applicant(s)

BERENS ET AL.

Examiner

Jason M. Nolan, Ph.D.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-36 is/are pending in the application.
- 4a) Of the above claim(s) 1,3-17 and 25-30 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35 is/are allowed.
- 6) ☒ Claim(s) 18,20,23,24,32 and 36 is/are rejected.
- 7) ☒ Claim(s) 19,21,22,31,33 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>01/17/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1 & 3-36 are currently pending in the instant application. No amended or new claims have been presented.

Information Disclosure Statement

Applicants' information disclosure statement (IDS), filed on 01/17/2006 has been considered. Please refer to Applicants' copy of the 1449 submitted herein.

Response to Restriction

Applicants' election without traverse of **Group V, Claims 18-24 & 31-36** is acknowledged. Further, Examiner acknowledges Applicants' submission of a new Abstract. For this reason the objection to the specification is withdrawn. The lack of unity restriction requirement, 11/21/2006, has been amended to include the missing Group:

Group VII: Claims 26-30, drawn to processes for making and using a compound according to formulae II¹, XII¹ or XIV¹.

Examination of **Group V, Claims 18-24 & 31-36** follows herein and the remaining **Claims 1, 3-17 & 25-30** are withdrawn from further consideration as being non-elected inventions.

Claim Rejections - 35 USC § 112, 2nd

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18 & 32 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites the language “reducing a compound of the formula II” and the scope of this term is unclear, such that it fails to define the metes and bounds of its limitation. Compounds according to formula II have the following functional groups that are susceptible to reduction: the amide carbonyl; the indolone carbonyl; and the indolone aromatic double bonds. It is only assumed that applicant intends to reduce the indolone carbonyl as depicted in Claim 19. A more descriptive term explaining the scope of the claim is required.

Claim 32 is rejected under 35 U.S.C. § 112, second paragraph as it recites the limitation “R⁵” for the definition of formula XIV⁵. There is insufficient antecedent basis for this limitation in the claim since it is not defined in claim 1 for formula II. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

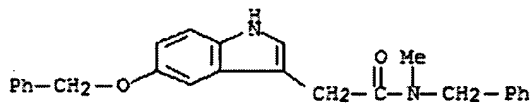
A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

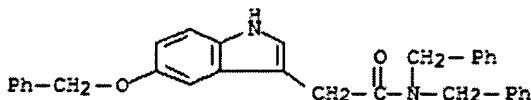
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Speeter, M. E. (US Patent 2,692,882; 10/26/1954). The following compounds read on the instant claim wherein $n = 1$; R_1 = substituted alkoxy; R_2 = hydrogen; and R_3 & R_4 = alkyl, substituted alkyl, or together form an alkylene ring with the binding nitrogen.

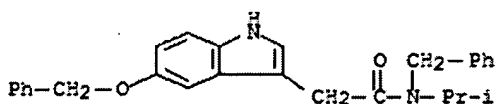
RN 725227-53-2



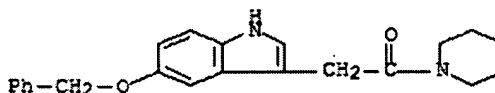
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RN 857776-54-6

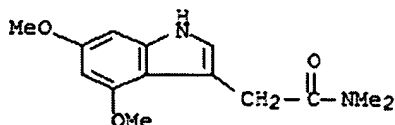


RN 872786-56-6



Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Brown *et al.* (*Journal of Heterocyclic Chemistry* **1969**, 6(4), 539-43). The following compound reads on the instant claim wherein $n = 2$; R_1 = alkoxy; R_2 = hydrogen; and R_3 & R_4 = alkyl.

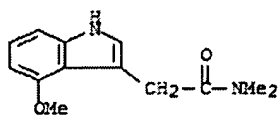
RN 23659-97-4



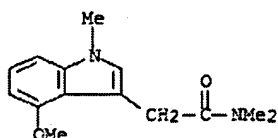
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Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Germain *et al.* (*Chimica Therapeutics* **1973**, 8(6), 647-51). The following compounds read on the instant claim wherein $n = 1$; $R_1 =$ alkoxy; $R_2 =$ hydrogen or alkyl (substituted or unsubstituted); and R_3 & $R_4 =$ alkyl.

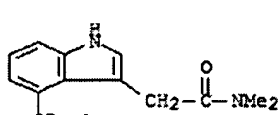
RN 52335-79-2



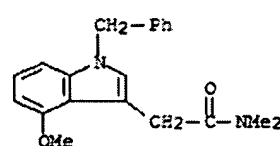
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RN 52335-80-5

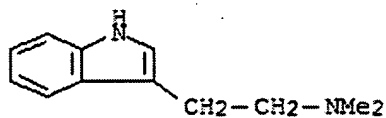


RN 52335-82-7

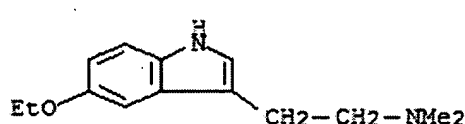


Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Hoshino *et al.* (*Ann.* **1935**, 520, 19-30). The following compounds read on the instant claim wherein $n = 0$ or 1; $R_1 =$ C₂-alkoxy; $R_2 =$ hydrogen; and R_3 & $R_4 =$ alkyl.

RN 61-50-7

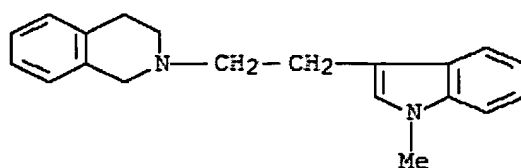


RN 855245-09-9



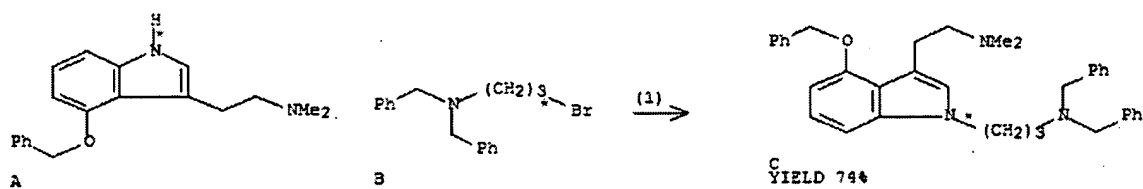
Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Julian *et al.* (*Journal of the American Chemical Society* **1948**, 70, 174-9). The following compound reads on the instant claim wherein $n = 0$; $R_2 =$ alkyl; and R_3 & $R_4 =$ alkyl that together form an alkylene ring with the binding nitrogen.

RN 855690-78-7



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Claim 24 is rejected under 35 U.S.C. 102(a) as being anticipated by Albers *et al.* (*Journal of Pharmacy and Pharmacology* **Sept. 2002**, 54(9), 1265-1270). The following process is described which reads on the instant claim wherein $n = 1$; R_1 = substituted alkoxy; R_2 becomes substituted alkyl; and R_3 & R_4 = alkyl. A strong base (NaH) and a substituted alkyl according to **Alk-L** are used.



RX(1) RCT A 28383-23-5

STAGE(1)

RGT D 7646-69-7 NaH

SOL 68-12-2 DMF

CON SUBSTAGE(1) 30 minutes, 0 deg C

SUBSTAGE(2) 30 minutes, 0 deg C

STAGE(2)

RCT B 98346-35-1

SOL 68-12-2 DMF

CON SUBSTAGE(1) 30 minutes, 0 deg C

SUBSTAGE(2) 4 hours, 60 deg C

SUBSTAGE(3) overnight, room temperature

PRO C 500003-01-0

Claim 36 is rejected under 35 U.S.C. 102(b) as being anticipated by Speeter, M. E. (US Patent 2,692,882; 10/26/1954) and Hoshino *et al.* (*Ann.* **1935**, 520, 19-30). The compounds shown above by Speeter anticipate formula XII¹ and the compounds shown above by Hoshino anticipate formula XIV¹.

Claim Objections

Claim 33 is objected to because of the following informalities: the term "by reduction of the compound of formula XX⁶" is unclear. Examiner suggests the amendment: "by reduction of the aldehyde carbonyl in the compound of formula XX⁶" in order to fully describe the invention. Appropriate correction is required.

Claims 19, 21 & 22 are objected to as being dependent upon a rejected base **Claim 18**, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

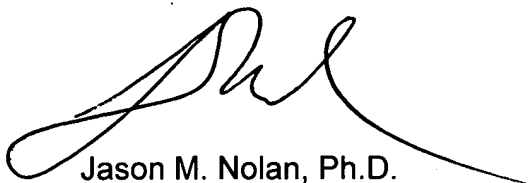
Claims 24, 31, 33 & 34 recite the term "or a method for the synthesis of a tryptamine derivative having pharmaceutically useful properties comprising said process." This term objected to as being redundant, i.e. not further limiting subject matter and not adding a patentable contribution to the claim. The processes are directed to tryptamine derivatives and whether or not those derivatives have pharmaceutically useful properties is an inherent property of each compound. Deletion of this term is suggested.

Allowable Subject Matter

Claim 35 is allowed. The transformation of a compound according to formula XIV wherein $n = 1$ and $R_1 = \text{halogen}$ to a compound of formula XX⁷ is free of the prior art.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jason M. Nolan, Ph.D.** whose telephone number is **(571) 272-4356** and electronic mail is **Jason.Nolan@uspto.gov**. The examiner can normally be reached on Mon - Fri (9:00 - 5:30PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Joseph M^cKane** can be reached on **(571) 272-0699**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason M. Nolan, Ph.D.
Examiner
Art Unit 1626



REBECCA ANDERSON
PATENT EXAMINER

Joseph K. M^cKane
Supervisory Patent Examiner
Art Unit 1626
Date: February 21, 2007